

REMARKS

By the foregoing amendment, applicant has cancelled claim 12 in order to materially reduce the issues on Appeal by eliminating the sole rejection of the claims under 35 U.S.C. 112, second paragraph. A minor typographical error in not cancelling the dangling term "of the" in claim 1 during the previous amendment of the claims on February 9, 2009, as well as a typographical error in the spelling of "ionomeric" in claim 11 has been corrected. Accordingly, entry of the forgoing amendment is proper:

Reconsideration and withdrawal of the previous rejection of claims 1-11, 13 and 16-17 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is respectfully requested.

Although the Examiner states that the phrases "independently consisting of a decorative material" in claim 1, line 8 and claim 10, line 9 are not supported by the original disclosure, no such phrases appear in claim 1 or claim 10. Rather, what does appear in claims 1 and 10 is the phrase "independently consisting of a decorative material selected from a group consisting of a thermosetting composite, thermoplastic composite, an elastomer foil, a thermoplastic foil, a fabric, a mineral, and a mineral composite". Support for the phrase in question is found in the PCT published application WO 2005/056288 at page 1, third full paragraph in the fifth sentence which states "each panel is provided with an upper decorative surface where the flooring system comprising panels with at least two of the decorative surfaces selected from the group consisting of a thermosetting composite, a thermoplastic composite, an elastomeric foil, a thermoplastic foil... a fabric, a mineral, a mineral composite", and thus, the phrases of the claims are clearly supported by the written description of the original disclosure. Specifically exemplified panels, such as found on page 2 second or third full paragraph, as well as page 3, first and second full paragraphs and the paragraphs bridging pages 3-4 give examples of such panels. If the examiner is alternatively arguing that applicants have used Markush format, or deleted one member of the listing of

materials from that disclosed in the specification as creating a written description defect, the examiner is kindly invited to cite any case authority to support such a position. Applicants are given exclusive authority to determine the subject matter that they regard as their invention (35 USC 112, second paragraph), which they have done here. Accordingly, applicants respectfully submit that the claims are fully supported by the written description requirement required by 35 U.S.C. 112, first paragraph.

Reconsideration and withdrawal of the various rejections of the claims under 35 U.S.C. 102 (anticipation) are respectfully requested. Specifically, withdrawal of the rejection of claims 1-2, 7 and 13 under 35 U.S.C. 102(b) as being anticipated by Grau (WO 03/060256) (hereinafter Grau WO) is respectfully requested. The Grau patent application (U.S. Patent 2005/0115181) is not a proper reference because it does not qualify as "prior art" under any applicable section of 35 U.S.C. 102, and thus cannot be used to sustain a rejection of anticipation. If the examiner contends that the Grau WO reference, though in a foreign language supports his rejection, the burden is upon the examiner to obtain a translation of Grau WO and he cannot shift this burden to applicants to obtain their own translation when it is clear that Grau WO does not support the examiner's contentions as will be discussed in detail below.

Furthermore, in order to constitute anticipation the prior art must teach each of the claimed elements in a single prior art reference. MPEP 2131.

While the Examiner, in his "Answer to applicants Arguments", beginning at page 18, and specifically in paragraph 21 argues that applicant's "claims do not limit each panel [of the panel system] to only having a single decorated surface or material" such misses the point the applicants' claims do limit that "each carrying panel is provided with an upper decorative surface on the upper side of the carrying panel", (emphasis added) and furthermore that "the flooring system comprising panels having at least two of the decorative surfaces being different from each other and independently consisting of a decorative material selected from

group consisting of a thermosetting composite, a thermoplastic composite, an elastomer foil, a thermoplastic foil, a fabric, a mineral and a mineral composite". Nowhere does applicant state that each of the panels of the flooring system be different from each other but specifically states that such decorative surfaces of at least two panels are different and consist of only specified materials. As applicants' claims are specific that "each carrying panel is provided with an upper decorative surface" that differs from the decorative surface of at least a decorative surface of a second panel, and is furthermore limited in the choice of structural materials from the Markush group specifying the materials for the decorative surface, applicants demand that the examiner address what applicants do claim, rather than what they do not claim.

While the Examiner can suggest that there are many decorative surfaces on a single panel, such is not the subject matter specified in the claims. Thus, the Examiner's interpretation of the claims is not only erroneous, but the paraphrasing of the applicants' claims followed by attributing such features to the Grau WO reference are clearly not supported by the Grau WO teaching. For the forgoing reasons, Grau WO cannot possibly act as an anticipatory reference because in the surface of the Grau panels there is "at least a series of identical and rigid slab framing modules (1,8), in at least one plane, the framing modules of the series being complementary so as to be placed relative to one another to form an exposed grid of said slabs (7), see Abstract of Grau WO 03/060256 A1. These framing modules (1, 8) are only shown in Fig. 8. The description of Fig. 8, beginning at page 25, line 23 of the WO Publication are formed of metal ("metallique") page 25, line 27. Framing module 8 is also formed of metal (page 26, line 6-"metallique"). Of course "metal" is a material specifically excluded by applicants' Markush group and thus its presence negates anticipation. Thus, while the Examiner states in the body of the rejection that "the surfaces of the panels [of Grau WO] are made of different materials" such is not true as metal is common to the decorative surfaces of all the Grau WO panels. Because Claim 1 specifically

requires that "each carrying panel is provided with an upper decorative surface" and further that "at least two of the decorative surfaces being different from each other" and "independently consisting of a decorative material selected from [a specified group excluding metal] the claims define over the teachings of Grau WO". Thus, the claims cannot possibly be anticipated by the Grau et al. WO teaching. Withdrawal of the rejection is therefore respectfully requested.

Reconsideration and withdrawal of the rejection of claims 1, 4-6, 8-10 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hansson et al. (U.S. Paten 6,465,046) is also respectfully requested.

Although applicants agree that Hansson '046 teaching a flooring system comprising a plurality of panels, wherein different patterns appear on at least two different panels, i.e. two portions of a map which, when the panels are assembled, show a larger view of the map, there is no teaching that at least two panels of the Hansson '046 flooring system comprise at least one panel which has a decorative surface selected from one of the materials in the Markush group and at least one other panel having a decorative surface which is different from that of the first material and additionally that such different material is also selected from another of the Markush group specified in claim 1.

While Hansson '046 has a map extending over several panels and thus the "décor" or "pattern" may be different for each panel, applicants do not claim a "décor" or "pattern" different on at least two panels, but rather a structural material of construction, i.e., a thermosetting composite on one panel and a non-thermosetting composite (e.g. a mineral) on another panel where the non-thermosetting composite is limited to only those specific materials from the group consisting of an elastomer foil, a thermoplastic foil, a fabric, a mineral and a mineral composite. While such above example of a thermosetting composite on one panel and a mineral on a second panel are merely exemplary of one embodiment of panels, one panel can be a thermoplastic composite and the other a non-thermoplastic

composite i.e., a fabric; so too, one can be a mineral and the other a non-mineral i.e., a thermoplastic foil. While any number of other possible combinations make claim 1 a potentially "broad" claim, the Examiner has found none of the teachings of such a "broad" claim in the Hansson et al. '064 patent. Accordingly, Hansson et al. cannot be anticipatory of the claimed invention.

Reconsideration and withdrawal of the rejection of claims 1, 10, 13 and 16 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103 (a) over Sjoberg (U.S. Patent Publication 2004/0170812) is respectfully requested.

While applicants agree that Sjoberg '812 teaches a flooring system comprising a plurality of panels with surfaces structures, there is no teachings in Sjoberg '812 of at least two panels of the flooring system being made of different materials selected the Markush group present in applicants' independent claims 1 and 10. Rather, each of the Sjoberg '812 flooring panels are all made of the same materials i.e., a thermosetting composite material, the Examiner has not pointed to one disclosure of Sjoberg '812 that shows there is any teachings to show a decorative surface of a different material in at least one of the panels in the flooring system, which is different from the decorative surface in at least a second panel in the Sjoberg '812 flooring system. Accordingly, Sjoberg '812 again fails to anticipate or make obvious the claimed invention.

Lastly, reconsideration and withdrawal of each of the stated rejections under 35 U.S.C. 103 (a) is respectfully requested.

Although the Examiner attempts to combine Martensson (U.S. Patent 6,397,547) in view of Sjoberg '812 in rejecting claims 1-3, 7 and 11 there is no teachings that the decorative surfaces in at least two of the panels differ in materials of construction. Although the Examiner cites column 3, lines 31-43 and Fig.2, panel number 1 as allegedly teaching that at least two of the decorative surfaces being a thermoplastic composite or a thermoplastic foil, Martensson (page 9, last two lines and page 10, first two lines of the office

action concedes that Martensson “fails to expressly disclose the panels being different and independently consisting of a decorative material [selected from a specified by the Markush group of materials].” The deficiencies of Sjoberg ‘812, noted above, in combination with the conceded failure of Martensson, does not establish a prima facie case of obviousness under 35 U.S.C. 103(a) because Sjoberg ‘812 has been demonstrated to fail to teach one panel comprising a decorative surface formed from at least one material of applicants’ Markush group of independent claim 1 and at least one other panel having a different decorative surface of a different Markush group material of independent claim 1.

Similarly, the rejection of claims 4-9 and 11 under 35 U.S.C. 103(a) as being unpatentable over Grau (WO ‘256) in view of Hansson ‘046 also does not establish a prima facie case of obviousness. Here the Examiner concedes that Grau (WO ‘256) “fails to expressly disclose at least two of the decorative surfaces being a thermosetting composite...thermoplastic materials” and Hansson ‘046 is only cited to teach flooring panels “where at least two of the decorative surfaces are a thermosetting composite”. However, it is clear that applicants’ invention is directed to a flooring system of at least two panels where the two panels have different decorative surfaces of different materials selected from the Markush group of applicants’ independent claim 1. Thus, these dependent claims 4-9 and 11 which depend, directly from, or indirectly from, independent claim 1 must also require (35 USC 112, fourth paragraph) that at least one of the panels be formed of one material, e.g., a thermosetting composite and the other panel of a non-thermosetting composite. This has not been achieved by the proposed combination of references.

Furthermore, in the rejection of claim 14 under 35 USC 103 (a) over Grau (WO ‘256) in view either Sjoberg (WO ‘906), or alternatively the rejection of claim 15, also under 35 USC 103 (a) over Grau (WO ‘256) in view of Sjoberg ‘812, also does not cure the foregoing deficiencies in the basic Grau (WO) teachings.

Independent claim 14 requires that "each panel [of the flooring system] is provided with an upper decorative surface" and furthermore "that at least one of the panels comprises a decorative surface comprising a thermosetting composite and at least one other panel of the flooring system comprising a decorative surface of an elastomeric foil."

With regard to claim 14, the Examiner concedes (paragraph 11 second sentence) that "Grau (WO'256) teaches the flooring system discussed above, however fails to expressly disclose panels when the elastomer foil comprises a thermoplastic elastomer."

Firstly, claim 14 contains no requirement that the elastomer foil comprise a thermoplastic elastomer.

Thus, there would appear to have been no reason to even combine Sjoberg '096 with Grau (WO).

Secondly, if the purpose of combining Sjoberg '096" with Grau (WO) was to show "flooring panels made of elastomeric foils comprise thermoplastic elastomer", the Sjoberg '096 panels do not teach elastomeric foils as a part of a decorative surface. To the contrary, Sjoberg '096 teach that the elastomer is "arranged between the upper side of the core and abrasion resistant thermosetting laminate" and thus, the "elastomer" is not visible and hence not part of the upper decorative surface of Sjoberg '096. Thus, there are no teachings of any panel in Grau (WO '256), as modified by Sjoberg '906, wherein the upper decorative surface is any elastomer foil.

Independent Claim 15 goes a step farther in requiring that one panel have a decorative surface of an elastomeric foil, while at least one other panel has a decorative surface of a high gloss thermosetting composite. This combination of Grau (WO) with Sjoberg '812 does not teach such a flooring system.

Thus, neither independent claim 14, or independent claim 15, can possibly be made obvious by the presence of the elastomer foil which is not present or visible part of the upper

decorative surface even though it contained within the panels of Sjoberg '096 or '812. Withdrawal of the rejections are therefore respectfully requested.

In rejecting the remainder of the claims, the examiner primarily recombines the aforementioned references discussed above with others of the references discussed above, but points to no further teaching in the references that cure the deficiencies noted above. Thus none of the rejections of claims 1, 10 and 17-20 establish a *prima facie* case of obviousness under 35 USC 103 (a).

The only additional rejection which mentions a new reference is in the rejection of claims 17 and 18 as unpatentable over the combination of Sjoberg '812 in view of Bettinger (US Patent 3,811,237), or of claim 19 over Sjoberg '812 in view of Martensson and Bettinger, each under 35 USC 103 (a)..

Bettinger is not directed to a flooring system where panels are provided with joining means on their edges as required in independent claim 1, upon which claims 17-19 are directly, or indirectly dependent. Rather, Bettinger wraps carpeting over the tops and edges of his floor panels 20 (Fig 5) and then juxtaposes a plurality of such "wrapped panels" next to one another (Figs 2-3). The result are panels which can shift relative to one another, making an unstable floor surface, with gaps between panels allowing the heels of women's shoes to fall into, and in no way provides any mechanism to tie the panels together.

Most importantly however, is the fact that the Bettinger teaching reinforces what is implicit in all of the art cited in rejecting the instant claims of this application – that no one skilled in the art had, prior to applicants' invention, thought to create a flooring system of floor panels with disparate decorative surfaces – yet provide means to join these panels together into a floor by providing joining edges on the panels.

Therefore, having failed to locate any prior art reference which anticipates, or through any possible combination of references to formulate a *prima facie* case of obviousness, withdrawal of all rejections and passage of the application to issue are respectfully requested.

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 14-1437, under Order No. 8688.049.US0000.

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